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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,123	12/15/2003	Amit Mor	1376ELB-US	4841
32964	7590	04/19/2005	EXAMINER	
DEKEL PATENT LTD., DAVID KLEIN BEIT HAROF'IM 18 MENUHA VENAHALA STREET, ROOM 27 REHOVOT, 76209 ISRAEL			COMSTOCK, DAVID C	
			ART UNIT	PAPER NUMBER
			3732	

DATE MAILED: 04/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/734,123

Applicant(s)

MOR, AMIT

Examiner

David Comstock

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

The drawings are objected to because they contain extraneous matter, which is not permitted. The labels in Figures 1-3 should be replaced with reference *characters* (see Response to Arguments, below). The reference characters and the features to which they correspond should be set forth in the specification. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 4, 6, 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by McGann (6,228,122).

McGann discloses a replacement ligament 20, i.e. a connecting band, capable of being attached at any desired location on a replacement femur and/or a replacement acetabulum (see, e.g., Fig. 1; col. 2, lines 8-41; col. 3, lines 43-45; and col. 4, lines 15-17). The locations at which the ligament attaches to the replacement femur and/or the replacement acetabulum are attachment zones. The replacement femur includes a stem 24 that is inserted into a femur (see Fig. 6). The ligament may be attached directly

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to the replacement femur and/or replacement acetabulum and need not pass through either (e.g., cf. Figs. 1 and 2). The ligament may be made from, for example, polyethylene, which is capable of being stretched (see col. 2, line 20 and col. 3, lines 9-12). It is noted that the ligament can be characterized as a replacement ligamentum teres femoris since it is a replacement, i.e. prosthetic, device and need not exactly match the natural structure which it replaces. Furthermore, it is noted that Applicant defines the ligamentum teres femoris to encompass "any shape or size, such as but not limited to, a wire, cord, string, ligament, band, ribbon, and the like" (Applicant's disclosure, page 4, lines 32-33). Furthermore, Applicant explains that the replacement ligamentum teres femoris "does not have to be attached to the same place on the femoral head and acetabular structure as the natural ligamentum teres femoris. Any attachment zone is within the scope of the invention." (Applicant's disclosure, page 5, lines 7-10).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over McGann (6,228,122).

McGann discloses the claimed invention except for explicitly disclosing that the device may be attached at a location corresponding to a fovea of a natural femoral

head. It would have been obvious to one having ordinary skill in the art at the time the invention was made to extend the ligament from a location corresponding to a natural fovea, since it has been held that mere relocation of parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over McGann (6,228,122) in view of Ficat et al. (3,064,645).

McGann discloses the claimed invention except for the stem having an alignment device. Ficat et al. discloses a femoral stem having an alignment device 2, i.e. the ribs, in order to ensure stability of the stem and prevent angular movement which could cause problems (see Figs 1 and 2 and col. 2, lines 65-68). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the prosthesis of McGann with an alignment device in view of Ficat et al, in order to ensure stability of the stem and prevent angular movement which could cause problems.

Response to Arguments

In response to Applicant's argument that the drawings do not require correction, the following is noted. First, it is apparent from Applicant's response that Applicant recognizes that "numerals are preferred" for reference characters (37 CFR 1.84(p)(1) and cf. 1.84(o)) . At the outset, it is unclear why Applicant does not wish to present the application in its preferred form. Regardless, Applicant takes "preferred" to mean that while numerals are preferred, word labels can also be used if desired. This is not accurate. Rather, numerals are preferred over letters or other *characters*. It is noted

that a character is not tantamount to a word or label; a character, of course, is a simple mark or symbol. Reference characters, preferably numerals, are used in order to emphasize the figures. Compare the statement regarding legends in 37 CFR 1.84(o) where it is noted that legends may be used *subject to approval by the Office*. However, *they should contain as few words as possible*. Here, it is possible to remove the words altogether and use reference characters, preferably numerals. While this applies to legends and not reference characters, it is clear that drawings should not contain unnecessary words and that the figures should be described using reference characters, preferably numerals, not words. 37 CFR 1.84(o) and (p)(1):

(o) *Legends*. Suitable descriptive legends may be used subject to approval by the Office, or may be required by the examiner where necessary for understanding of the drawing. They should contain as few words as possible.

(p) *Numbers, letters, and reference characters*.

(1) Reference characters (numerals are preferred), sheet numbers, and view numbers must be plain and legible, and must not be used in association with brackets or inverted commas, or enclosed within outlines, e.g., encircled. They must be oriented in the same direction as the view so as to avoid having to rotate the sheet. Reference characters should be arranged to follow the profile of the object depicted.

In response to applicant's argument, regarding claim 5, that attaching the device at a location corresponding to a fovea of a natural femoral head provides proprioceptive advantages, the fact that applicant has recognized another advantage which would flow naturally from the prior art cannot be the basis for patentability when the differences would otherwise be obvious, as set forth in the rejection. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Applicant's remaining arguments have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Comstock whose telephone number is (571) 272-4710. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



D. Comstock
15 April 2005



EDUARDO C. ROBERT
PRIMARY EXAMINER